



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

24 DEC 1990

Group 210  
Art Unit 212  
dli

Paper No. 80

In re application of

Ole K. Nilssen :  
Serial Number: 06/787,692 :  
Filed: October 15, 1985 : DECISION ON PETITIONS  
For: INVERTER WITH RESONANT :  
L-C CIRCUIT :

Two Petitions are before the Group Director for decision. First for consideration is a PETITION RE IMPROPER RESPONSE TO PREVIOUS PETITION, filed on November 23, 1990, following a decision by the undersigned resulting in the return of earlier filed Petition papers with respect to an allegedly improper final rejection. The papers had been returned as not falling within decorum requirements of 37 CFR 1.3. This "first" petition has been forwarded to undersigned for reconsideration of the issue. The second Petition is entitled REVISED PETITION RE IMPROPER FINAL REJECTION, and embodies a request for review under 37 CFR 1.181 with respect to the Examiner's designation of a rejection as "final." Both the "first" and "second" Petitions are addressed within this single Decision letter.

Specifically with respect to the "first" petition, it is once again noted that comments personally disparaging the Examiner have been presented within correspondence directed to the Official application file record. This issue has been addressed repeatedly. All such papers deemed to fail in conducting business with the Patent and Trademark Office with decorum and courtesy will be returned. The subject petition is DISMISSED.

The "second" Petition, now in acceptable form with respect to 37 CFR 1.3, references a Board of Patent Appeals and Interferences decision of November 30, 1989, affirming the rejection of certain claims on appeal. In its decision, the Board recommended specific rejections of previously allowed claims, and remanded the application to the Examiner, permitting Petitioner a period of two (2) months within which to respond to the recommended rejection by submitting to the Examiner an appropriate amendment and/or a showing of facts to overcome said recommended rejection.

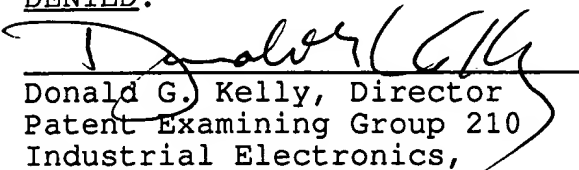
At the heart of this issue is the following series of events. After the Board's presentation of recommended rejections, Petitioner availed himself of the opportunity to present an "appropriate response" as afforded under 37 CFR 1.196d. This response was ultimately determined to be inappropriate, and the Examiner subsequently rendered an Office Action wherein he maintained the proposed rejections, repeating and embracing the Board's own rationale (as he is required to do under the noted Rule). The Examiner made the Official Action FINAL.

It would appear from this record of events that a clear issue was developed on the question of patentability of the claims on remand. The Examiner is well aware of Office policy that dictates bringing prosecution to as speedy conclusion as possible. While Petitioner is to be dealt with justly, needs of the general public for timely determination of claim scope cannot be ignored. On the other hand, present practice does not sanction hasty and ill-considered final rejections.

On review, and for the record, the decision at bar seems neither hasty nor ill-considered. Inasmuch as the Board's suggested rejection on new grounds is, in fact, a recommendation as opposed to a first rejection on those grounds (normally to be followed by a second or final rejection), the question as to whether Petitioner technically received a full hearing on this point is fairly raised. In this context it is noted that general PTO practice with respect to final rejections seeks to avoid a situation where an applicant is confronted for the first time with a ground of rejection in an action closing prosecution. Clearly this is not the case in this special situation where the Board has effectively communicated the rejection to Petitioner, and opportunity for appropriate relief is available under the Rules of Practice. It is also noted, with respect to the issue of timeliness, that Petitioner has received as much as four actions (rejections) in addition to the Examiner's Answer on Appeal. The Examiner's designation of the subject Action as "FINAL" is deemed appropriate in terms of both fairness and timeliness. Thus the Petition is DENIED. The finality of the outstanding rejection stands, and the period set for appropriate response thereto continues to run for THREE MONTHS.

It is noted that the Board, following conclusion of the proceedings before the Examiner, will either adopt its earlier decision as final or will render a new decision based on all appealed claims, as it considers appropriate. Such final action by the Board will give rise to alternatives available to Petitioner following a decision by the Board.

In SUMMARY, the "first" Petition (seeking reconsideration of an earlier Petition returned for non-compliance with 37 CFR 1.3) is DISMISSED and the associated papers are returned for non-compliance with 37 CFR 1.3. The "second" Petition (seeking to change the designation of a final action to non-final status) is DENIED.

  
Donald G. Kelly, Director  
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